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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,192	04/26/2000	Anuradha Narasimhaswamy	199-1408	9889

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EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,192

Applicant(s)

NARASIMHASWAMY ET AL.

Examiner

Carl Colin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33,37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 2/04/2004, Applicant amends claims 1, 12, 16, 20, 27, and 33 and cancels claims 34-36, the following **claims 1-33, 37-41** are presented for examination.
2. The amendments to the specifications, and to the drawing, filed on 2/04/2004, have been considered. The rejection of claims 1, 20, 27, and 33 under 35 U.S.C. 101 has been withdrawn.
3. Applicant's arguments, see pages 9-11, filed on 2/04/2004, with respect to the rejection of claims 12 and 20, under 35 USC 102 (e) have been fully considered but are not persuasive. Applicant states referring to claim 12 that Morris does not disclose a password associated with disclosure. On page 13, lines 11-17, Morris discloses authenticating a scientist as author of the document that could be password protected and also suggests using any technology known in the art. Morris further discloses limited access to documents. On page 12, Morris suggests that passwords or other forms of authentication can be used with respect to technical documents, workspace or desktop, screen, so each element may be associated with a password. Morris discloses the claimed method of claim 12. Examiner respectfully asserts that claim 12 recites "password associated with said disclosure" but does not disclose each disclosure has an associated password. Therefore claim 12 is still rejected under 35 USC 102.

Referring to claim 20, Applicant states that Morris does not teach locking the disclosure to prevent further editing. Morris discloses access control of document and applying digital signature and referring to electronic signature technology known in the art as mentioned in the previous Office Action. A digital signature can be appended to the disclosure to lock the disclosure. In addition, on page 22, pages 23-29, when verifying using the verification window, the disclosure is locked. Applicant amends claims 1, 16, and 27 to recite the locking step by reciting after approval. New limitations have been added. Upon further consideration, a new ground of rejection is made in view of Graziano and Carter respectively in combination with the teaching of Morris to clearly disclose the locking step after approval. Graziano teaches the locking of document after approval of any parties and approval log comprising date of approval. Claim 33 has been amended to recite approval log comprising a date of approval by the first user. Applicant's disclosure, page 14 recites an approval log becomes associated with the disclosure once all inventors approve the invention disclosure. Therefore claim 33 has new matter. Regarding the dependent claims, the teaching of Morris in the first Office Action still applies as far as disclosing other limitations not challenged by Applicant.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 33 and the intervening claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 33 has been amended to recite approval log comprising a date of approval by the first user. Applicant's disclosure, page 14 recites an approval log becomes associated with the disclosure once all inventors approve the invention disclosure. Disclosure does not support a log by the first user.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.1 **Claims 12-15 and 20-26** are rejected under 35 U.S.C. 102(e) as being anticipated over Foreign Patent WO-01-08031 (21 July 1999) to **Morris et al.**

5.2 **As per claim 12, Morris et al.** discloses an invention disclosure system (see claim 1 and figure 3) comprising that meets the recitation of claim 12. A computer system comprises of a user computer, web server, database, and computer display. **Morris et al.** further discloses a user computer; a web server having an identification subsystem (see claim 1 and page 13, lines 1-17); a database coupled to the server (see figure 3); said server providing user screens to said users so users provide disclosure information to said server, receiving disclosure information from said users, storing information in said database, prompting the user to provide a password; and allowing access to said disclosure after storing said information in said database upon entering the password associated with the disclosure (see pages 13-14, 22).

As per claim 13, Morris et al. discloses the limitation of further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see page 11, lines 12 et seq.).

As per claim 14, Morris et al. discloses the limitation of wherein said server creates a user log (see page 12 line 1 et seq.).

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As per claim 15, Morris et al. discloses the limitation of wherein said server associates said approval log with said disclosure (see page 12).

As per claim 20, Morris et al. discloses a method of forming an online invention disclosure comprising: forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information and a second inventor identification from a user computer (see page 13 and figure 4); as the plurality of selected information is entered into the user computer, storing the information in a central storage location (page 9, lines 1-7 and page 11, lines 15-18); prompting approval of said first inventor; notifying the second inventor; and prompting the second inventor to approve the disclosure (see page 13 and claims 3 and 4); and locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure (page 14, lines 1-10; page 11, line 12 et seq.; page 12).

As per claim 21, Morris et al. discloses the limitation of further comprising the step of generating an approval log (see page 21).

As per claim 22, Morris et al. discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see pages 13 and 21).

As per claim 23, Morris et al. discloses the limitation of further comprising associating the approval log with the disclosure (page 21).

As per claim 24, Morris et al. discloses the limitation of further comprising locking the disclosure when the second user approves the disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.).

As per claim 25, Morris et al. discloses the limitation of further comprising locking the disclosure when the first user approves the revised invention disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.).

As per claim 26, Morris et al. discloses the limitation of wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein (see page 16, lines 6-10 and page 8, lines 8 et seq.). **Morris et al.** discloses making disclosure electronically accessible and using hyperlink to access disclosure.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1 **Claims 1-11, 16-22, 27-33, and 37-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Foreign Patent WO-01-08031 (21 July 1999) to **Morris et al.** in view of US Patent 5,191,613 to **Graziano et al.**

6.2 **As per claim 1, Morris et al.** substantially discloses a method of forming an online invention disclosure comprising: forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information from a user computer (see figure 6a); as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location (see claim 1); and prompting approval of said first inventor (see figure 6b). **Morris et al.** does not explicitly locking the disclosure after approval to prevent further editing. However, **Graziano et al.** in an analogous art teaches a method of locking a document after received acknowledgement to prevent further editing of the disclosure, for example (see column 12, lines 21-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Morris et al.** to lock the disclosure after approval to prevent further editing as taught by **Graziano et al.** in order to avoid tampering. This modification would have been obvious because one of an ordinary skill in the art would have been motivated by the suggestion provided by **Graziano et al.** so as to avoid tampering.

As per claim 16, **Morris et al.** discloses a user computer; a server (see figure 3 and claim 1); a database coupled to the server (see figure 3); said server providing user screens to said users so users provide disclosure information to said server providing user screens to said users to prompt said users to provide disclosure information to said server, receiving disclosure information from said users including a first inventor identification and a second inventor identification, storing information in said database, prompting the first inventor and the second inventor to provide an approval (see page 22 and page 20 lines 10-11). Claim 16 also recites the same limitation of locking disclosure after approval found in the rejected claim 1 except for stating by the first and the second inventor. **Graziano et al.** discloses single and multiple parties and stating any of the parties. Therefore claim 16 is rejected on the same rationale as the rejection of claim 1.

As per claim 27, **Morris et al.** discloses a method of forming an online invention disclosure comprising: entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention disclosure (see page 13 and figure 4); storing the information in a central storage location (page 9, lines 1-7 and page 11, lines 15-18); prompting approval of the one or more inventors (page 14, lines 1-10; page 11, line 12 et seq.); locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the one or more inventors approve the disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.). **Morris et al.** further discloses that electronic signature technology may be used after the inventors approve the disclosure, such electronic signature as well known in the art as disclosed by the inventor has the ability to lock the disclosure from

further editing (see page 13, lines 1-17). Claim 27 also recites the same limitation of locking disclosure after approval of one or more inventors found in the rejected claim 1. Therefore claim 27 is rejected on the same rationale as the rejection of claim 1.

As per claims 2 and 28, Morris et al. discloses the limitation of further comprising the step of generating an approval log (see page 21).

As per claims 3 and 29, Morris et al. discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see pages 13 and 21).

As per claims 4 and 30, Morris et al. discloses the limitation of further comprising associating the approval log with the disclosure (page 21).

Claim 33 has the same limitation as the rejected **claims 27, 28, 29, and 30**. Therefore, **claim 33** is rejected on the same rationale as the rejection of **claims 27, 28, 29, and 30**. Claim 33 further adds date of approval of the first user. **Graziano et al.** discloses for example (column 15, lines 14-23) creating log for first party comprising date of event and date of verification.

As per claim 5, Morris et al. discloses the limitation of wherein forming is performed by a non-inventor author (see page 13).

As per claims 6 and 37, Morris et al. discloses the limitation of wherein the step of forming comprises identifying a second inventor; and further comprising the steps of notifying the second inventor; and, prompting the second inventor to approve the invention disclosure (see page 13 and claims 3 and 4).

As per claims 7 and 38, Morris et al. discloses the limitation of further comprising revising the disclosure by the second inventor to form a revised disclosure, and prompting the first inventor to approve the revised disclosure (see page 13 and claims 3, 4, 82, and 83).

As per claims 8, 31, and 39, Morris et al. discloses the limitation of wherein prompting the second inventor comprises providing an E-mail to the second inventor (see page 16, lines 6 et seq.).

As per claim 9, Morris et al. discloses the limitation of wherein prompting comprises the step of prompting the approval of an associated document (see page 13, lines 18 through page 14).

As per claim 10, Morris et al. discloses the limitation of wherein said associated document is selected from a group consisting of an assignment document and a power of attorney (see page 26).

As per claim 11, Morris et al. discloses the limitation of further comprising allowing access to various users for obtaining the information (see page 13).

As per claims 17 and 18, Morris et al. discloses the limitation of wherein said server associates said approval log with said disclosure (see page 12).

As per claim 19, Morris et al. discloses the limitation of further comprising a directory system coupled to said server whereby upon providing identification information to server, said server retrieves user information from the directory system in response to the identification information (see page 11 and figure 2).

As per claim 26, Morris et al. discloses the limitation of wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein (see page 16, lines 6-10 and page 8, lines 8 et seq.). **Morris et al.** discloses making disclosure electronically accessible and using hyperlink to access disclosure.

As per claim 40, Morris et al. discloses the limitation of further comprising locking the disclosure when the second user approves the disclosure (see claim 9; see also page 14, lines 1-10; page 11, line 12 et seq.).

As per claim 41, **Morris et al.** discloses the limitation of wherein said document is selected from a group consisting of an assignment document, an agreement and a power of attorney (see claim 36, see also page 26).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US Patent 6,182,078 Whitmyer, Jr.

This patent pertains to a system to deliver professional services. Many of the claimed features, i.e. e-mail, log approval, etc. are disclosed in this reference.

b. Foreign Patent JP 11126223 A Takano et al.

This patent pertains to a system to perform patent using communication networks such as the Internet. Many of the claimed features, i.e. approval between two inventors, invention notification, etc. are disclosed in this reference.

7.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

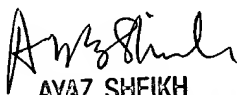
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

April 15, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100